

Remarks/Arguments

In response to the Office Action mailed October 19, 2005, independent claim 15 has been amended.

Claims 18-19, 21, 22, and 24 have been amended.

After entry of this amendment, claims 15-19 and 21-26 remain.

It is respectfully submitted that each and every feature recited in the amended claims are fully supported in the specification as filed. No new matter has been added.

Applicants wish to thank the Examiner for the careful review of the claims, specification and drawings.

Rejections under 35 USC 103(a)

The Office Action has rejected apparatus claims 15-19 and 21-26 under 35 USC 103(a) as being unpatentable over AAPA (Applicant's admitted prior art) including Lenz et al. (US 5,534,751) by incorporation in view of Yasushi Arai (JP11214487), hereinafter "Lenz" and "Arai."

Applicant has amended independent claim 15 and dependent claims 18, 19, 22, and 24 to provide for proper dependency with antecedent and to the parent claim. This feature is supported in the specification as filed.

Applicant has amended claim 21 to depend from claim 19 instead of claim 15 to address the dependency from the appropriate parent claim.

Applicant specifies in amended claim 15 the relative positioning of the stepped hanger structure and the hanger assembly with respect to the top ring. The amendment to claim 15 also clarifies that the hanger assembly is coupled to one surface (e.g., the top surface in the example of Fig. 3) of the top ring and projecting in one direction without traversing through the set of lower rings. On the other hand, the stepped hanger structure is coupled to the opposite surface (e.g., the lower surface in the example of Fig. 3) of the top ring and projecting in the opposite direction while traversing through at least one ring of the set of lower rings.

Since these features are not disclosed or suggested in the cited prior art, alone or in combination, amended claim 15 should be deemed novel, nonobvious, and patentable.

With regard to the Office Action assertions, the Office Action (page 3) suggested that "AAPA as modified by the teaching of Yasushi Arai would allow some one to lift the rings placed on the stepped hanger attached to the top ring with lock bore, pass the larger hole of the bore through the hanger adapter and twist for a small angle of let the plunger of the hanger adapter move to the smaller hole to lock it in place."

It is respectfully submitted that the Office Action fails to show any suggestion in the prior art to combine AAPA and Arai. More importantly, as discussed later herein, there is no suggestion in the prior art to combine AAPA and Arai in the angular offset manner stated in the context of amended claim 15.

Applicant wishes to direct Examiner's attention to In re Mills:

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Furthermore, the Office Action (pages 3-4) suggested that "Another reason why this would not be allowable, is the fact that in order to apply the teaching of Yasushi Arai the stepped hanger would have to be installed offset since, as **can be seen best in Fig 2 of specification**, installing stepped hanger (235) in line with the locking bore (205) would not make it work." (Bold emphasis added).

Applicant respectfully traverses.

In this case, the Examiner is using Applicant's teaching to explain how the prior art should be combined and as support for the Examiner's obviousness conclusion. This approach, it is respectfully submitted, is impermissible hindsight.

Applicant wishes to direct the Examiner's attention to the point in MPEP 2144.04(VI)(C). Ex parte Chicago Rawhide Mfg., Co. pointed out that "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The

prior art must provide a motivation or reason for the worker in the art, **without the benefit of appellant's specification**, to make the necessary changes in the reference device.” (Underline and bold emphasis added).

The Office Action (page 4) pointed out that “**installing stepped hanger (235) in line with the locking bore (205) would not make it work**.” (Underline and bold emphasis added).

Applicant completely agrees that inline installation would not be feasible and thus the offset feature is critical in the context of the invention of amended claim 15.

For the operation to be achievable, the locking bore must be angularly offset (i.e., at a different angle relative to the stepper hanger) in the manner claimed in claim 15 from the stepper hanger (as recited in claim 15 and as can be seen in Fig. 2 wherein the stepper hanger 235 is angularly offset from bore 205).

It is respectfully submitted that the angular offset feature is a critical feature and is not merely a rearrangement of parts since as pointed out by the Examiner, the combination would not work without the offset feature.

However, the Office Action's (page 4) response to Amendment suggested “Applicant however does not explain criticality.” Applicant respectfully traverses.

Since Applicant and the Examiner both agree that the offset feature is a feature that is **critical** to make the invention work, it is logical then that the angular offsetting is NOT merely a rearrangement of parts. In fact, without this offsetting, the arrangement is not functional, as mentioned by the Examiner. Having said this in this Amendment and in the previous amendment in the case, Applicant does not believe that Applicant “does not explain criticality.” The offset feature is critical because if the stepper hanger (235) is inline with the locking bore 205, the combination would not work.

Applicant notes, however, the Office Action's (page 4) response to Amendment pointed out that “the offset is merely as a consequence of the application of the teaching of Yasushi to AAPA and is a mere mechanical convenience. **It is not critical** since the **stepped hanger could be anywhere on the ring 200 and would work fine**. It is further noted that the stepped hanger, already disclosed in the prior art, has a circular shaft at the top. The teaching of Yasushi Arai requires an elongated hole for the locking bore.

Therefore the two could not be concentric and **stepped hanger would obviously be offset from the locking bore.**” (Underline and bold emphasis added).

Applicant respectfully submits that the Office Action response to Amendment that the offset is not critical is inconsistent with the earlier Office Action’s suggestion that the offset feature is critical.

Furthermore, applicant respectfully submits that the Office Action’s assertion that the stepped hanger cannot be inline with the locking bore is inconsistent with the Office Action’s assertion that the stepped hanger is not critical and could be anywhere on the ring 200 and would work fine.

Applicant respectfully submits that Ex parte Chicago Rawhide Mfg., Co. is the controlling law in this case. Applicant respectfully submits that neither AAPA, Arai, nor Lenz suggests or teaches this critical offset feature. In fact, this critical feature, in the manner claimed in the combination of amended claim 15, is not available to the worker in the art without the benefit of appellant’s specification.

These amended features are also not suggested by Arai or AAPA, alone or in combination. For these reasons and others, it is submitted that independent claims 15, as amended, is novel, nonobvious, and patentable. It is further submitted that the claims that depend therefrom, in addition to being patentable due to their dependence from the patentable parent claims, also recite other patentable features. Accordingly, the allowance of these claims is also respectfully requested.

For the aforementioned reasons and others, it is respectfully submitted that the pending claims are novel, non-obvious, and patentable over the cited art of record, taken alone or in combination.

Conclusion

In view of the discussion herein, Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at 408-257-5500.

If any petition is required to facilitate the entry of the present amendment, please consider this communication a petition therefore as well. The Commissioner is authorized to charge any fees beyond the amount enclosed which may be required, or to credit any overpayment, to Deposit Account No. 50-2284 (Order No. LMRX-P040).

Respectfully submitted,

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